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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,328	08/14/2001	Brandon Yip	025	6832

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EXAMINER

CURTIS, CRAIG

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,328

Applicant(s)

YIP ET AL.

Examiner

Craig H. Curtis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Disposition of the Instant Application

- This Office action is responsive to Applicants' Amendment A filed on 30 April 2003, which has been made of record in the file as Paper No. 8.
- By this amendment, Applicants have amended claims 1, 26, 29, 33, and 35.
- Claims 1-39 are currently pending in the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al. (6,142,624) in view of Brandt et al. (5,93,147).

Morris et al. discloses the invention as claimed--a coated optical lens including:

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an ophthalmic lens element (100); and

a coating on a surface of said lens element (col. 15, ll. 30-32)--EXCEPT FOR the additional teaching wherein said coating on said surface of said lens element exhibits a substantially balanced reflectance from the centre to a radius proximate the edge of said lens element.

Brandt et al., however, teach a coating (See abstract, and Fig. 5) which provides substantially balanced reflectance from the centre to a radius proximate said edge (in this case of a mirror face). (It is noted that Applicants' substantially balanced reflectance admits a broad range of interpretation; more critically, the meaning Applicants associate with this claimed phrase has not been read into the claims, since although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.)

It would have been obvious to one having ordinary skill in the art at the time the invention was claimed to have modified the invention of Meyers such that its coating provide substantially balanced reflectance from the centre to a radius proximate said edge, as taught by Brandt et al., for at least the purpose of significantly improving the imaging performance of said optical lens.

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The combination further teaches wherein said ophthalmic lens element includes a surface of high curvature upon which said [substantially] balanced reflectance coating is deposited. See, e.g., Fig. 6© in the Morris et al. patent.

The combination further teaches wherein said lens element is of generally ovaline shape and is located on the surface of a sphere whose radius of curvature corresponds to 11 D or above. See col. 4, ll. 4-7 in the Morris et al. patent.

The combination further teaches wherein said coating functions as an anti-reflective coating, the multicoloured nature of these and other coatings being well-known in the art. See, e.g., col. 15, ll. 24-30 in the Morris et al. patent.

The combination further discloses Applicants' multi-coated teachings (Morris et al.: Id.), the recited reflected colour differences being inherently met by the combination.

The combination further discloses Applicants' method teachings, wherein, inter alia, a high refractive index material and a low refractive index material are overlapped, such teachings being encompassed by at least the disclosure by Morris et al. of standard optical coatings. See col. 15, ll. 24-30.

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Response to Arguments

2. Applicants' arguments filed on 30 April 2003 have been fully considered but have not been found to be persuasive. Although Applicants are correct in stating that the Brandt et al. invention is quite different and conceptually unrelated to reducing variation [in percentage reflectance as a function of angle of incidence] with position across the recited "curved surface," and that Brandt et al.'s invention is restricted to reflectance at a single monochromatic wavelength, whereas the present invention relates to a coating that exhibits a "substantially balanced reflectance" when inspected visually, the newly applied primary reference provides, as set forth both therein and above, the use of coatings in terms of visual appearance. Indeed, the Brandt et al. reference is relied upon solely to meet Applicants' "substantially balanced reflectance" limitation, a recitation which, despite Applicants' stated position, the Examiner still holds to be inherently indefinite and which, for this reason, has been interpreted broadly in the above-recited rejection of the claims.

In an effort to expedite the prosecution of the instant application, the Examiner respectfully notes that although Applicants can associate a specific definition with a claimed term or phrase, such a definition should not be overly broad. In the

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instant case, the definition of "substantially balanced reflectance," as explicitly defined at page 3, lines 24-30 of the specification, makes use of an either/or phrase--namely, "...such that variations in visual appearance are **either** imperceptible **or** generally acceptable to an observer." (Emphasis added) The examiner respectfully asserts that certainly at least one observer would find the variations in visual appearance of the coated or multi-coated optical lenses of the combination to be *either* imperceptible *or* generally acceptable. Moreover, the phrase "balanced reflectance" itself admits a broad range of interpretation, a fact which the adverbial modifier "substantially" only compounds.

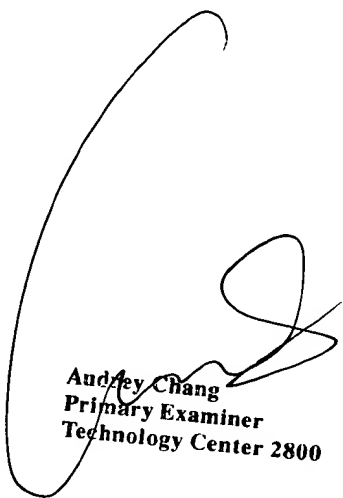
Applicants are invited to contact the Examiner (at their convenience) at (703) 305-0776 prior to responding formally to this Office action, for the purpose of discussing any issues raised by same.

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Contact Information

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig Curtis, whose telephone number is (703) 305-0776. The facsimile phone number for Art Unit 2872 is (703) 308-7721.

Any inquiry of a general nature regarding the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-0956.



Audrey Chang
Primary Examiner
Technology Center 2800

Craig H. Curtis
Craig H. Curtis
Group Art Unit 2872
10 July 2003